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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,157	10/12/2000	John J. Sie	19281-000800US	8624
20350	7590	06/01/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			GROSS, KENNETH A	
		ART UNIT		PAPER NUMBER
		2122		//
DATE MAILED: 06/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/687,157	SIE ET AL.	
	Examiner	Art Unit	
	Kenneth A Gross	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 10.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This action is in response to the amendment filed on March 24th, 2004.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 8, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Grapes (U.S. Patent Number 6,446,130).

In regard to Claim 1, Grapes teaches: (a) receiving a command from the content distributor to store the program at the user location. Grapes does teach a video display which displays selections of multimedia content to a user terminal from the content distributor (Column 6, lines 53-65, specifically, item (1)). These choices are sent to the user, and are received from the content distributor, and can be seen as commands in that they are processed by the user, which based on the selection by a user, allows a content to be stored at the user location; (b) processing the command (Column 7, lines 7-12); (c) receiving the program at the user location (Column 17, lines 1-7); (d) storing the program at the user location in response to at least the processing of the command (Column 15, lines 49-59); and (e) detecting a user action related to the program after storage of the program (Column 13, lines 3-10).

In regard to Claim 8, Grapes teaches: (a) commanding the user location to store the program from the content distributor (Column 17, lines 2-7); and (b) sending the program to the user location for storage before a user requests the program. Grapes teaches predetermined packages, which have been differentiated from user selected packages, indicating that predetermined content is content that is not selected by a user, but predetermined by a different source (See Figure 3a, item 25b “load content database”, and at Column 12, lines 1-3).

Claims 14-16 are product claims that correspond to method Claims 1-3, respectively, and are rejected for the same reasons as Claims 1-3, respectively, where Grapes teaches a product for carrying out said method of Claims 4-6 (Figure 1A).

For specific rejections of Claims 2, 3, 13, and 15, see the action mailed on February 11th, 2004.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6, 9, 12, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grapes (U.S. Patent Number 6,446,130) in view of Satterfield (U.S. Patent Number 6,305,017).

For specific rejections of Claims 4-6, 9, 12, and 17-19, see the action mailed on February 11th, 2004 (Note: Claim 9 has been amended to overcome certain 112 2nd paragraph issues, and the scope of the claim has not changed).

5. Claims 7, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grapes (U.S. Patent Number 6,446,130) in view of Hall et al. (U.S. Patent Number 5,920,861).

For specific rejections of Claims 7, 11, and 20, see the action mailed on February 11th, 2004.

Response to Arguments

6. Applicant's arguments filed March 24th, 2004 have been fully considered but they are not persuasive.

In regard to Claims 1, 8, and 14, the applicant argues that Grapes does not teach “receiving a command from the content distributor to store the program at the user location” (Page 8, Paragraph 3). However, Grapes does teach a video display which displays selections of multimedia content to a user terminal from the content distributor (Column 6, lines 53-65, specifically, item (1)). These choices are sent to the user, and are received from the content distributor, and can be seen as commands in that they are processed by the user, which based on the selection by a user, allows a content to be stored at the user location.

In regard to Claim 8, the applicant argues that Grapes does not teach “sending the program to the user location for storage before a user requests the program” (Page 8, Paragraph 3). However, Grapes does teach predetermined packages, which have been differentiated from user selected packages, indicating that predetermined content is content that is not selected by a

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user, but predetermined by a different source (See Figure 3a, item 25b “load content database”, and at Column 12, lines 1-3).

In regard to the USC 103(a) rejections, the applicant argues that “motivation for the specific combination of elements is lacking along with any reasonable likelihood of success in that combination” and that it is assumed that Official Notice is being relied upon. In order to clarify this matter, let it be stated that **no** Official Notice is being taken in these rejections, and that the motivation to combine can be found in the motivational statements at the end of the rejections that rely on Satterfield or Hall to overcome the limitations lacking in Grapes.

Therefore the arguments made in regard to this matter are moot.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KAG



TUAN DAM
SUPERVISORY PATENT EXAMINER